

REMARKS/ARGUMENTS

The Examiner separated the 30 original claims into three groups of claims asserting that each group of claims was a distinct invention because the three groups were related as subcombinations disclosed as usable together in a single combination. Examiner's assertion that the claim groups were subcombinations usable together was based on Examiner's explanation of separate utility for each claim group. Applicant respectfully submits that this explanation of utility is not accurate. The utility for each claimed invention is the same. With an incorrect explanation of utility, Examiner's assertion that the claim groups are subcombinations usable together cannot stand. Thus the claimed inventions are not distinct.

The utility advanced in the Office Action for claim groups II & III was not the invention's utility, but simply one element of a claim.

The explanation of utility for claim groups II & III was based on one element taken from the body of the claims and erroneously presented as the utility of the entire invention; while the utility of claim group I was correctly found from the preamble and not the claim elements. The Examiner described the utility of claim group 1 "as generating index information for audiovisual objects." This parallels the preamble of Claim 1 which recites "generating index information for audiovisual objects." Examiner described the utility of claim group 2 "as converting from one language to another language" while the preamble of Claim 28 of claim group 2 recites "generating index information for a data object." Likewise, Examiner described the utility of Claim 30 of claim group 3 "as patterning recognition module" while the preamble of invention 3 recites "providing index information for audiovisual objects."

Thus the cited utility of claim group 1 was taken from the preamble, while the cited utility for claim groups 2 and 3 was taken from elements within the body of the claims. By advancing utility from the preamble in some claims and from the body in other claims an artificial distinction in utility was created. The fundamental utility for all the claims is indexing data objects for computerized information retrieval systems. Data objects include audio objects, graphical objects, audiovisual objects and so forth. In other words, the invention has utility as a system and method of managing and protecting digital rights in

data objects. All of the claimed inventions provide this utility by processing data objects to generate index information. This index information is generated for indexing by, or delivery to, information retrieval systems, e.g. search engines.

Thus the utility for this invention is correctly found in the preamble of the claims and not from the various claim components. Consider an example claim of a wheel for a bicycle: "A wheel for a bicycle comprising a hub; a set of metal spokes uniformly protruding from said hub; and a metal rim circling said hub and attached to said metal spokes." Reading this claim it is apparent that the utility of this example invention does not lie in a set of metal spokes. The set of metal spokes is merely an element or component of this invention and not the underlying utility. The invention is a wheel and not spokes. Thus the utility is not making spokes possible, but making travel possible for a bicycle.

Additionally, this utility remains the same as long as the elements of the invention form a bicycle wheel. For example, if in a second example claim, a carbon fiber disk was used in place of the the metal spokes, the invention and utility would still be a wheel. In constructing the wheel, either the disc or the spokes could be used. Since only one of the possible elements is needed, the two example claims are not separately usable.

Similarly in the present invention, the language conversion step, and the pattern recognition module correspond to the spokes and circular disc on the wheel. Each are elements or steps of the claim, but they are not the underlying utility of the claim. The language conversion step and the pattern recognition module are element components used to form a single invention. The invention for all claims of the present invention is a system and method of generating index information for data objects. Thus the utility is not making language conversion or pattern recognition possible, but making information retrieval possible for rights-protected data objects. The three groups of claims all do this. Therefore the three groups of claims have the same utility and are not distinct from each other.

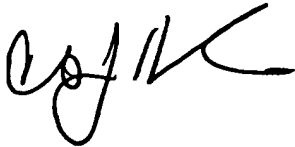
The Examiner has a serious burden to appropriately explain distinctness in an initial restriction requirement. See MPEP § 803. Because the explanation of distinctness advanced in the restriction requirement is based on an artificial distinction in utility, the Examiner has not made a *prima facie* showing of distinctness.

Appl. No. 09/456,793
Reply dated Oct.. 22, 2003
Reply to Office action of July, 28, 2003
Atty. Docket No. 03.0074

Conclusion

For all of the reasons advanced above, Applicant respectfully submits that the restriction requirement was improper. Applicant kindly requests withdrawal of the restriction requirement and examination of all the claims.

Respectfully Submitted,



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Date: 10-22-2003

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